

REMARKS

Reconsideration of this application is respectfully requested. Claim 1 has been amended to incorporate the features of claim 18, which has been cancelled without prejudice or disclaimer. Claim 29 has been cancelled without prejudice or disclaimer. Claim 11 has been amended to correct dependency. Claims 1, 2, 6, 7, 11-17, 20, 22-25, and 27 have been amended to bring the claim language into conformity with U.S. practice.

Claims 1, 2, 6, 7, and 11-17, and 19-28, and 30-32 are pending. No new matter has been added.

Claim Rejections – 35 U.S.C. § 102

Claims 1, 2, 7, 26 and 32 have been rejected under 35 U.S.C. § 102(b) as anticipated by Tatsuhiko et al. (JP 09-058650). According to the Examiner, Tatsuhiko discloses a paper carton suitable to be filled with liquid contents made of a resin layer and a paper layer, and that adhesives can be used between the layers (*see* Office Action, page 2). The Examiner further contends that Tatsuhiko discloses the same adhesives and paper coatings that are presently claimed. Regarding claim 2, the Examiner contends that Tatsuhiko discloses a single or multi-layer resin layer with adhesives possible between the resin layers. Regarding claim 7, the Examiner contends that Tatsuhiko discloses adhesive layers that comprise ethylene methacrylic acid and maleic anhydride polypropylene. Finally, the Examiner states that Tatsuhiko discloses the use of ethylene as the polyolefin as recited in claim 32.

Applicants traverse the rejection and respectfully request reconsideration.

The pending claims are not anticipated directly or inherently by the cited prior art. In order for a reference to anticipate claims under § 102, the reference must disclose each and every limitation of the claimed invention, and must be an embodiment of the claimed invention. *Dana Corp. v. Am. Axle & Mfg., Inc.*, 61 USPQ2d 1609 (Fed. Cir. 2002). The teaching must *clearly disclose the invention with a certain degree of precision*, without the need for picking and

choosing components. *Ex parte Westphal*, 223 USPQ 630 (Bd. Pat. App. 1983) (emphasis added). Furthermore, “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may result* from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, (Fed. Cir. 1999).

Applicants respectfully submit that Tatsuhiko fails to anticipate the present claims because it fails to teach each and every limitation of the claimed invention, either expressly or inherently. According to the Examiner, Tatsuhiko discloses the use of polyethylene imine paper coatings to promote adhesion, and the use of DIKKU dry AC108 in paper coatings. The Examiner interprets DIKKU dry AC108 as “having a formula that is the same as formula I in applicants claims” (*see* Office Action, page 2). However, the Examiner has not provided any basis or support for the assertion that DIKKU dry AC108 encompasses any of the claimed formulas. The Examiner has also failed to establish that the claimed formulas are “necessarily present” in DIKKU dry AC108. Therefore, Tatsuhiko does not “clearly disclose the invention with a certain degree of precision” or provide a basis for inherent anticipation. Therefore, the requirements to establish inherency have not been established, and Applicants respectfully request that this rejection be withdrawn.

Claim Rejections – 35 U.S.C. § 103

Claims 6, 17, 30 and 31 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Tatsuhiko in view of U.S. Patent No. 5,358,785 (“Akao”). The Examiner contends that Akao discloses multilayer laminated films that are formed using extrusion processes. The Examiner concludes that it would have been obvious to combine the inventions of Tatsuhiko with Akao to arrive at the claimed invention because the films disclosed in Akao have greater tear and puncture strengths (*see* Office Action, page 4).

Applicants traverse the rejection and respectfully request reconsideration.

impair the shielding of the barrier layer. In this regard, the laminate and its components disclosed in Tatsuhiko teach away from the claimed invention.

In view of the foregoing, the cited references, either alone or in combination, would not have led a person of ordinary skill in the art to arrive at the claimed invention. Therefore, Applicants respectfully request that this rejection be withdrawn.

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Claims 11 and 12 are have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Tatsuhiko in view of U.S. Patent No. 5,942,320 ("Miyake"). The Examiner contends that Miyake discloses multilayer barrier composite films with gas barrier properties against water vapor, oxygen, and aromatic components. Therefore, the Examiner concludes that it would have been obvious to combine Tatsuhiko with Miyake based on these properties (*see* Office Action, page 5).

Applicants traverse the rejection and respectfully request reconsideration.

For at least the foregoing reasons, claim 1 is not obvious in view of Tatsuhiko because it fails to teach or suggest a laminate that includes a denatured polyethylene imine represented by formula I or formula II. Tatsuhiko also does not teach or suggest a laminate that includes at least an adhesive resin layer/a barrier resin layer/an adhesive resin layer, laminated by co-extrusion, onto a base paper where the base paper has an imine coat on its surface to enhance its adhesion to the adhesive resin layer, and the lamination by co-extrusion set to occur at a temperature as low as 290°C or less. Miyake does not cure these deficiencies. Since claims 11 and 12 depend from claim 1, which is not obvious in view of the cited references, this rejection should also be withdrawn.

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